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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,146	02/22/2002	Douglas Rawson-Harris	22078/0001	1778

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EXAMINER

THOMAS, DAVID B

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,146

Applicant(s)

RAWSON-HARRIS, DOUGLAS

Examiner

David B. Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claim language is unclear as to whether the applicant is claiming a tool for driving a security screw, a particular security screw, or a combination of a driving tool and a security screw.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

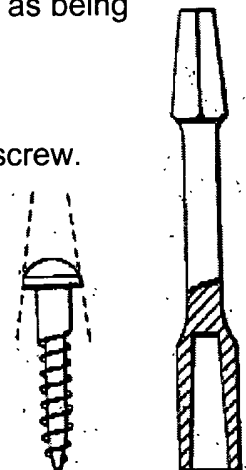
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 15, as well as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Smith (755,804).

Smith ('804) discloses both a screw and a means for operating the screw.

The head of the screw has a conical gripping surface and the tool has a complimentary gripping surface.



***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17 and 18, as well as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith ('804), as applied to claim 15 above, in view of Faroni (3,924,507).

As discussed above in the rejection of claim 15, Smith ('804) discloses both a screw and a means for driving the screw. Smith ('804) discloses that the purpose of his invention is to provide a screw that may be readily inserted into or withdrawn from any article by the necessary appliance but cannot be removed otherwise. Smith ('804) further discloses that the screw head may have various forms, as illustrated by Figs. 1-5, and may be convex, concave, or flat, or the head may have an inner groove (Figs. 1 and 2), wherein an inner side of the internal groove is slightly tapered such that the appropriate driving tool can frictionally engage and drive the screw. Thus, Smith ('804) discloses the claimed invention, as well as understood, except for specifically engaging the driving tool with the concave or the convex surface of the screw head. Faroni ('507) also discloses a theft-resistant fastener apparatus. The examiner relies upon Faroni ('507) for teaching that it would be obvious to modify an existing tool for the purpose of engaging the head of a theft-resistant fastener. In the specific case of Faroni ('507), the fastener has a convex head, thus the portion 16 of the tool, which engages the convex

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head 21 of the fastener, is ground to a smooth concave surface (Col. 3, lines 51-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the driving tool of Smith ('804) such that the tool of Smith ('804) would have a greater contact with the smooth exposed surface of the security fastener, whether the smooth exposed surface be concave, convex, or flat, as Faroni ('507) teaches modifying a driving tool to have an engaging surface which is complimentary to the surface shape of the head of the fastener, the benefit of which being that in a situation where the operation of the fastener and the driving tool rely solely upon friction for rotating the fastener with the tool, providing a greater contact surface between the tool and the fastener increases the effectiveness of the driving tool's ability to impart sufficient torsional force to rotate the fastener into the workpiece or to remove the fastener from the workpiece.

8. Claims 16 and 20, as well as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith ('804), as applied to claim 15 above, in view of Bjorklund et al. (4,233,880).

Smith ('804) discloses the claimed invention, as well as understood, except for specifying that the tool be made from the same material as the fastener, or for specifying austenitic stainless steel as a choice of material, however Smith ('804) discloses that the fastener may be made from copper, gunmetal, iron, steel, or any suitable alloy (Pg. 2, lines 34 and 35). Regarding the issue of using austenitic stainless steel, Bjorklund et al. ('880) teaches the desirability of manufacturing a fastener from austenitic stainless steel, thus making the fastener of Smith ('804) would have been an

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obvious modification. Regarding the issue of the fastener and the driving tool being made from the same material, the examiner, respectfully, contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture both the driving tool and the fastener from the same material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) ("Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.); and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious).

9. Claim 19, as well as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith ('804), as applied to claim 15 above, in view of Cerny (4,800,787).

Smith ('804), as applied to claim 15 above, discloses the claimed invention except for the provision of a power drill for rotating the driving tool. Cerny ('787) discloses a system for installing a vandal-resistant screw and teaches that the driving tool may be driven by a power drill (Col. 2, lines 45-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the shank of the driving tool of Smith ('804) such that the driving tool could be rotated by a power drill, as Cerny ('787) clearly teaches that using a power drill to drive

the driving tool would have been obvious.

***Response to Arguments***

10. Applicant's arguments with respect to claims 15-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. Thomas whose telephone number is (703) 308-4250. The examiner can normally be reached on 7-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (703) 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David B. Thomas  
Patent Examiner  
Art Unit 3723



dbt